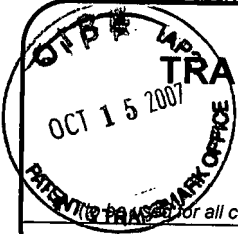


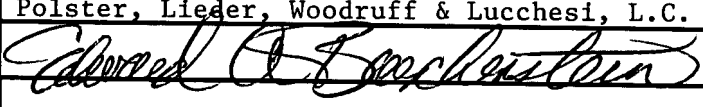
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 <b>TRANSMITTAL FORM</b> (Please use for all correspondence after initial filing)	Application Number	09/819,194
	Filing Date	March 28, 2001
	First Named Inventor	J. H. Labuschagne
	Art Unit	3637
	Examiner Name	A PHI DIEU TRAN
Total Number of Pages in This Submission	Attorney Docket Number	TIMK-7938US

### ENCLOSURES (Check all that apply)

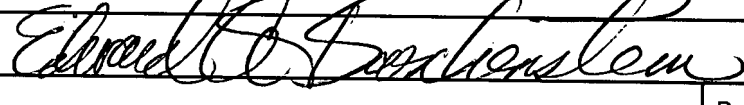
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Remarks		

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Polster, Lieder, Woodruff & Lucchesi, L.C.		
Signature			
Printed name	Edward A. Boeschstein		
Date	October 11, 2007	Reg. No.	22,986

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**PATENT**

**Practitioner's Docket No. TIMK 7938US**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re application of: J. H. Labuschagne**

**Application No.: 09/819,194**

**Filed: March 28, 2001**

**For: PORTABLE FACILITY AND PROCESS FOR RECONDITIONING ANTIFRICTION BEARINGS**

**Art Unit: 3637**

**Examiner: A, PHI DIEU TRAN**

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**APPELLANT'S REPLY BRIEF**

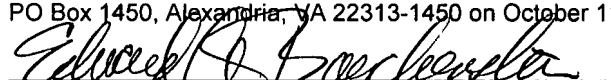
On April 17, 2007, applicant filed an Amended Appellant's Brief in the above-designated patent application. The examiner responded with an Examiner's Answer dated August 22, 2007. This paper addresses issues raised in the Examiner's Answer.

**I. THE DRAWINGS**

Applicant did not discuss the drawings in the Amended Appellant's Brief because at that stage of the prosecution the drawings appeared to be perfectly acceptable. Now the examiner, on one hand, states drawings constitute a "ground of rejection... applicable to the appealed claims" and, on the other hand, "objects" to the drawings. Applicant addresses the matter as a rejection suitable for review by the Board.

Citing 37 CFR 1.83(a) and MPEP 608.02(d), the examiner objects to the drawings "because they fail to show the different equipments/means for as described in the specification." To be sure, Rule 1.83(a), as the examiner notes, states that the

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Edward A. Boeschstein, Reg. No. 22,986

drawings must show every feature of the invention specified in the claims. But the rule goes on to state – and the examiner ignores – that “conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical symbol or a labeled representation (e.g., a labeled rectangular box).” Apparently, the examiner wants an illustration of each piece of equipment in the enclosure 50 of the portable reconditioning facility A as well as on the rear deck 66. But the application describes the equipment as “conventional” (page 9, lines 6 and 7), and therefore one skilled in the art of reconditioning bearings would have no difficulty visualizing each piece of equipment and knowing its details. Since the equipment is conventional, it may be depicted generally as it is in the application. The drawings satisfy the requirements of Rule 1.83(a).

Interestingly enough, the drawings in the Bellas patent, which serves as the primary reference for rejecting the claims under 35 USC 103, do not show any more detail in equipment, except perhaps for the hydraulic lift 40, than do the drawings now in the application under appeal. If the drawings of the application do not provide sufficient detail for a proper understanding of the invention, then the Bellas patent does not provide enough detail to support a rejection under 35 USC 103.

The drawing rejection typifies the prosecution of the application. First an issue arises, then it disappears, then it reappears. In the official action of July 6, 2006, the examiner objected to the drawings with the same wording now appearing in the latest rejection of the claims. Applicant, in the Response to Official Action filed October 6, 2006, requested reconsideration of the demands on the drawings, observing that the

equipment that the examiner sought to have illustrated in detail was conventional. In the official action dated October 31, 2006, the examiner remarked, "the objection to the drawing is hereby withdrawn." Hence, applicant did not address the drawing issue in the Amended Appellant's Brief and was surprised to again encounter the issue.

## **II. THE CLAIM REJECTION UNDER 35 USC 103**

The Examiner's Answer recites word for word the rejection of the claims that appeared in official action of July 6, 2006. Applicant addressed those claim rejections in the Amended Appellant's Brief filed April 17, 2007.

Despite the citation of numerous secondary references, most relating to equipment for servicing bearings, the real issue in this appeal resides in whether or not the Bellas patent has any pertinence to the invention set forth in the claims. The claims pertain to a portable facility for reconditioning antifriction bearings, some being specific enough to be confined to tapered roller bearings (claims 8 – 19) and others being specific enough to be confined to antifriction bearings used on the axle journals of railcars and locomotives (claims 20 – 29).

The Bellas patent has nothing whatsoever to do with such bearings. It pertains to a mobile garage for performing routine maintenance and minor repairs on automobiles. In relation to antifriction bearings, automobiles are massive and require heavy equipment, such as lifts, to perform the services. But the services performed require a relatively low level of skill. Antifriction bearings, on the other hand, are small and require entirely different equipment to recondition them, not to speak of different and considerably more advanced skills. For example, those who recondition bearings must know how to measure the diameters of cones (page 12), to remove minor spalling

from the cones (page 12) and from the cups (page 13), to select replacement rollers of equivalent types and sizes (page 13), to measure so-called “bench lateral” which involves selecting spacers of the correct length for separating the cones (page 14), to apply the correct amount of grease (page 15), and to correctly install seals (page 15). Those skills and procedures are not found at automobile repair facilities. The differences in skill together with the differences in equipment would deter one of ordinary skill in the art of reconditioning bearings from considering the Bellas patent. That patent has nothing whatsoever to do with reconditioning bearings.

The examiner characterizes applicant's invention as simply “servicing” bearings and reasons that the Bellas patent discloses such services because, at the end of one sentence, it refers to providing enough side working space to replace and grease wheel bearings. Applicant's invention and the claims that define it go well beyond “servicing.” They concern “reconditioning” bearings, and the Bellas patent is entirely devoid of any disclosure or suggestion relating to reconditioning. To characterize applicant's invention as simply “servicing” antifriction bearings is disingenuous and inappropriate.

If anything, the Bellas patent teaches away from applicant's invention. The Bellas patent calls for an enclosure large enough to accommodate an automobile and equipment for actually lifting an automobile to gain access to its underside. Within the enclosure only minor servicing procedures are performed – for example, changing oil and antifreeze or replacing spark plugs and wiper blades. Surely, the facility of the Bellas patent cannot accommodate disassembly of an automobile or its drive train, which would be necessary if the automobile were “reconditioned.” Contrast that with the portable facility as set forth in the claims. It relates to relatively small bearings that can

be, and usually are totally disassembled in the facility, even to the extent of removing bearing cages and releasing the rolling elements that they confine – and that makes “reconditioning” markedly different from simply “servicing.” The Bellas patent and applicant’s invention involve different and incompatible concepts. Simply because an automobile is serviced in a portable facility, does not suggest that an antifriction bearing can be reconditioned in a portable facility.

The examiner questions the declaration of R. Karich, which forms part of the Evidence Appendix in the Amended Appellant’s Brief. That declaration addresses factors set forth in Graham v. John Deere for evaluating obviousness – including the level of skill in the art. R. Karich identifies an individual of ordinary skill as one having a technical degree and also having familiarity with reconditioning antifriction bearings. Who else would a bearing company turn to when seeking a better way to recondition antifriction bearings? R. Karich remarks that he has at least ordinary skill. He also observes that one skilled in the art would not turn to a mobile service station when seeking a better way to recondition antifriction bearings. The examiner seems to take issue with applicant’s identification of one skilled in the art, but offers nothing else.

As discussed in the Amended Appellant’s Brief at page 15, the equipment in the Bellas patent that the examiner ascribes to servicing bearings has nothing to do with bearings. For example, the water in the water compartment is for diluting antifreeze, not cleaning bearings. None of the Bellas equipment suggests multiple stations at which service procedures are performed, much less procedures for reconditioning antifriction bearings as the claims require.

Applicant prepared and filed its Amended Appellant's Brief before the U.S. Supreme Court released its decision in KSR v. Teleflex, 82 USPQ 2d 1385. In that decision, the court remarked that the teaching-suggestion-motivation test that evolved through Federal Circuit cases, provides a helpful insight into the issue of obviousness provided that it does not become a rigid and mandatory formula. The court went on to observe that "common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle."

The Bellas patent does not resonate with that observation. First, Bellas patent does not disclose a "familiar item." How often does one see a portable garage facility on the streets of our cities? Never. Secondly, the equipment and skills identified with the Mobil Service Station Unit of the Bellas patent differ so markedly from the portable facility for reconditioning bearings set forth in the claims that one skilled in reconditioning bearings would never look to a mobile garage for suggestions. Perhaps that accounts for the total absence of portable reconditioning facilities for bearings in actual practice and in literature.

On October 10, 2007, the Patent Office published in the Federal Register (Vol. 72, No. 95, Page 57526) guidelines for determining obviousness in view of the KSR decision. Insofar as work in one field prompting variations of the use in another field, the guidelines require examiners to articulate certain "findings," namely –

- (1) a finding that the scope and content of the prior art, whether in the same field of endeavor as that of the applicant's invention or a different field of endeavor, included a similar or analogous device (method, or product);

- (2) a finding that there were design incentives or market forces which would have prompted adaptation of the known device (method, or product);
- (3) a finding that the differences between the claimed invention and the prior art were encompassed in known variations or in a principle known in the prior art;
- (4) a finding that one of ordinary skill in the art, in view of the identified design incentives or other market forces, could have implemented the claimed variation of the prior art, and the claimed variation would have been predictable to one of ordinary skill in the art; and
- (5) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

As the discussion in the Amended Appellant's Brief and in this brief demonstrate, the prosecution of the application is devoid of the foregoing findings or else conflicts with the evidentiary declarations that applicant submitted. With regard to design incentives and market forces, the application under the heading "Background of the Invention" discusses the traditional practices in the bearing industry that applicant sought to improve, and they demonstrate how detached the Bellas patent is from solving problems involving those practices. When wheel sets for railcars are removed for work at a wheel shop, primarily due to wear along the treads and flanges of the wheels, the bearings of those wheel sets are stripped from their journals and shipped to a bearing manufacturer to be reconditioned. This requires transporting the bearings and keeping track of them. It further requires the wheel shop to keep a large inventory of replacement bearings. The portable facility set forth in the application solves those problems by enabling the reconditioning equipment to be brought to the wheel shop. The Bellas patent did not recognize this problem, nor did it solve it. One of ordinary skill



in reconditioning bearings would have a permanent reconditioning facility in mind and nothing else, notwithstanding all the "common sense" such as a person could muster. The Bellas patent would not dispel this mindset. So despite the Bellas patent and the KSR decision, one of ordinary skill in the art of reconditioning bearings would never make a bearing reconditioning facility portable so that it could be brought to a wheel shop – and that is what this application here under appeal is all about.

In view of the foregoing, reversal of the rejection of all claims on appeal is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, reading "Edward A. Boeschstein". The signature is written in black ink and is positioned above the printed contact information.

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